

### **Remarks**

Claims 29-44 are pending in the present Application. Claims 29, 31-36, 38-40, 42, and 43 stand rejected; claims 30, 37, and 41 are objected to; and claim 44 has been withdrawn from consideration for being drawn to a non-elected invention.

Pending claims 29, 30, 34, 35, 38, 42, and 43 are amended by the above Amendment. Support for these amendments can be found at least in each of the original claims as previously pending and in the originally filed specification on page 2, lines 25-31; page 3, line 8 through page 6, line 4; page 6, line 22 through page 7, line 9; and page 22, lines 6-8.

New claims 45-51 are added. Support for these new claims can be found in original claims 35 and 37 as previously pending and in the specification on page 2, lines 25-31 (claim 45); original claim 36 as previously pending and in the specification on page 2, lines 30-31 (claim 46); claims 38, 40, and 41 as previously pending and in the specification on page 2 lines 25-32 and page 3, lines 1-17 (claim 47); claim 39 as previously pending and in the specification on page 2, lines 30-31 (claim 48); claim 41 as previously pending and in the specification on page 2, line 29 (claim 49); claim 40 as previously pending and in the specification on page 2, lines 25-32 and page 3, lines 1-17 (claims 50 and 51).

Applicant submits that no new matter is added to the application by the above Amendment.

Applicant respectfully requests reexamination and reconsideration of the case based on the amended claims. Each of the rejections levied in the Office Action is addressed individually below to the extent it relates to the amended claims.

**I. Rejection under the judicially created doctrine of obviousness-type double patenting.** Claim 34 has been rejected by the Examiner under the judicially created doctrine of obviousness-type double patenting as being unpatentable over issued claim 1 in U.S. Patent 6,825,169, issued November 30, 2004.

Without conceding the Examiner's position and solely in the interest of expediting prosecution, Applicant submits herewith a Terminal Disclaimer over U.S. Patent 6,825,169 signed by an attorney of record in this case. Statements under 37 CFR § 3.73(b) evidencing the ownership interests of Trustees of Tufts College and New England Medical Center Hospitals,

Inc. in the parent application USSN 07/781,552 were previously filed in this case. In view of this submission, the Examiner is respectfully requested to reconsider and withdraw the rejection.

**II. Rejection under 35 U.S.C. § 112, second paragraph, for being indefinite.** Claims 34, 42, and 43 have been rejected by the Examiner under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 34 has been amended to recite a pharmaceutical composition comprising the compound of claim 29 and a pharmaceutically acceptable carrier or diluent. Applicant submits that the amended claim is definite rendering the Examiner's rejection moot.

Claims 42 and 43 are intended to embrace compounds which contain amino acid residues with side chains (a) that form a cyclic structure with the peptide backbone (*i.e.*, where the broken line represents a bond between the amino/amide N atom and the side chain of the amino acid (*e.g.*, proline)) and (b) that do not form a cyclic structure (*i.e.*, where the broken line represents the absence of a bond). Applicant has amended claims 42 and 43 to make this more clear. Specifically, when a bond is present between the amino/amide N atom and the amino acid side chain, H' is absent. When no bond exists between the amino/amide N atom and the amino acid side chain, H' is present on the amino/amide N to fulfill the proper valency for the N atom. Applicant submits that the amended claims 42 and 43 are definite and render the Examiner's rejection moot.

The Examiner has also stated that claim 42 is indefinite when R is hydrogen given that the broken line can represent a bond. As would be readily apparent to one of ordinary skill in the art, when R is H, the broken line must present the absence of a bond to form a chemically stable compound. That is, H has a valency of only 1. Applicant submits that claims 42 and 43 are abundantly clear in this respect to one of ordinary skill in the chemical arts.

**III. Rejection under 35 U.S.C. § 102, as being anticipated by U.S. Patent 4,935,493.** Claims 29, 31-36, 38-40, 42 and 43 stand rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4,935,493 ("the '493 patent"). According to the Examiner, the '493 patent discloses Ser-Thr-Pro-Pro-boroPro and boroPro-pinacol.

Claims 29, 35, 38, and 42 are amended to recite that the claimed compound is "of the structure" as shown in the claim. The '493 patent does not disclose these claimed compounds; therefore, Applicant requests that the rejection be removed.

Furthermore, the Examiner maintains that the '493 patent discloses Ala-boroPro and Pro-boroPro. Claims 42 and 43 has been further amended to recite that p is an integer between 1 and 4, thereby excluding these dipeptide analogs. Applicant, therefore, requests that the rejection be removed.


The compounds of new claims 45-51 are similarly not disclosed in the '493 patent.

In view of these amendments, withdrawal of the rejection under § 102 is respectfully requested.

In view of the forgoing arguments, Applicant respectfully submits that the present case is now in condition for allowance. A Notice to that effect is requested.

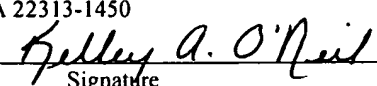
Please charge any fees that may be required for the processing of this Response, or credit any overpayments, to our Deposit Account No. 03-1721.

Respectfully submitted,

  
C. Hunter Baker, M.D., Ph.D.  
Registration Number: 46,533

Choate, Hall & Stewart LLP  
2 International Place  
Boston, MA 02110  
t (617) 248-5000  
f (617) 248-4000  
chb@choate.com

Date: April 24, 2006

|   |   |
|---|---|
| <b>Certificate of Mailing</b>   |   |
| I certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 |   |
| April 24, 2005<br>Date  | <br>Signature |
| _____<br>Typed or Printed Name of person signing certificate  |   |